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MAY 16 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100
DECISION ON PETITION
TO MAKE SPECIAL
(ACCELERATED EXAMINATION)
UNDER M.P.E.P. §708.02 (VIII)

In re Application of: Morishita, et al.
Application No. 10/783,018
Filed: February 23, 2004
For: REMOTE COPY SYSTEM

This is a response to the petition filed 28 January 2005 under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02 (VIII): Accelerated Examination, to make the above-identified application special.

The Petition is **DISMISSED**.

M.P.E.P. §708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. §1.102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (a) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
- (b) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status;
- (c) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. The pre-examination search must be directed to the invention as claimed in the application for which special status is requested. A search made by a foreign patent office satisfies this requirement;
- (d) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and
- (e) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new

application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given one opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Technology Center (TC) Special Program Examiner.

The petition filed 28 January 2005 fails to adequately meet requirement (e) of the criteria set forth above. The discussion of the references does not point out with the particularity required by 37 CFR 1.111(b) and (c) how the claimed subject matter is patentable over the references. The discussion fails to discuss each of the references; only three of the fourteen references deemed "most closely related" are discussed in any detail. Additionally, the discussion fails to point out how each reference defines over each independent claim. Some of the limitations purported to distinguish independent claims 8, 9, and 10 from the references (set forth on page 6 of the petition) are not in these claims. Some examples are set forth below.

-Claim 8 fails to specify that "*the network apparatus transfers* an access request issued from the host computer and destined to *the first primary volume*, to the second primary volume" (emphasis added).

-Claim 9 fails to specify that "*the network apparatus transfers* an access request *issued* from the host computer and destined to *the first primary volume*, to the second *primary volume*" (emphasis added). Also in claim 9: lines 21 and 22, the word "subsystem" is used rather than "system"; and in lines 23 and 29, the "second storage system" is recited rather than the "*third* storage system".

-Claim 10 fails to specify that "*the network apparatus transfers* an access request issued from the host computer and destined to *the first primary volume*, to the second *primary volume*" (emphasis added). Claim 10 also fails to specify that "data stored in the first primary volume is migrated to the second *primary volume*" (emphasis added) and that the "second storage system stores write data received from the host computer and the data received from the first storage system *and stored in the first primary volume*, into the second primary volume" (emphasis added).

Petitioner should ensure that the above discussion is directed to how the language of **each** of the independent claims is **specifically** distinguishable and patentable from **each** of the references provided in requirement (d) above.

Petition to Make Special **DISMISSED**.

Petitioner is given one opportunity to perfect the petition. Any request for reconsideration must be filed within TWO MONTHS of the mail date of this decision.

Until the renewed petition is submitted, the application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.

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